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MS APPEAL BRIEF - PATENTS
PATENT
0965-0232P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of Before the Board of Appeals
Toshiro NISHI et al. Appeal No.:

Appl. No.: 09/118,833 Group: 1746
Filed: July 20, 1998 Examiner: J. Crepeau
Conf.: 9403
For: SOLID ELECTROLYTE TYPE FUEL BATTERY

REPLY BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 29, 2004

Sir:

Transmitted herewith is a Reply Brief on behalf of the appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on September 29, 2004.


☐ An extension of time under 37 C.F.R. § 1.136(b) to was requested on and was approved on .

☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
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Attachment(s)



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Commissioner for Patents
P.O. Box 1450
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November 29, 2004

Sir:

This Reply Brief is respectfully submitted on behalf of Appellants in response to the newly submitted arguments of the Examiner in the Examiner's Answer dated September 29, 2004, which issued in connection with the above-identified application. In accordance with 37 C.F.R. §41.41, these new points of argument are responded to in the instant Reply Brief.

Status of Rejections

The rejection under 35 U.S.C. §112, first paragraph of claim 29 has been withdrawn.

The rejections under 35 U.S.C. §§ 102 and 103 over Soma (U.S. Patent 5,411,767) as been withdrawn.

Claims 4-30 are rejected under 35 U.S.C. §103(a) over JP '913 (JP 08-050913) in view of Soma.

New Points of Argument in the Examiner's Answer

At pages 3 to 6 of the Examiner's Answer, the Examiner maintains the rejection under 35 U.S.C. 103(a) over JP '913 (JP 8-50913) in view of Soma (U.S. Patent No 5,411,767). In maintaining this rejection, the Examiner uses language and rationales that parallel those in paragraph 6 at pages 5-7 of the Final Office Action mailed January 15, 2004.

In the Response to Argument at pages 6-8 of the Examiner's Answer, the Examiner refutes the distinctions of the invention presented over JP '913 and Soma set forth in the Appeal Brief. For example, although the Appeal Brief noted that Soma is non-analogous art, the Examiner takes the position that Soma is part of the same field of endeavor.

Further, the Examiner asserts that the Declarations Under 37 C.F.R. 1.132 only pertain to Soma alone, and the Soma rejections have been withdrawn. The Examiner now takes the position that Soma is now only used

for materials and not for teachings pertaining to sintering or plasma spraying. At page 6, line 19 to page 17, line 1 of the Examiner's Answer, the Examiner states: "Soma is merely relied upon as teaching the specific materials suitable for use in this method."

However, this rationale indicates that the Examiner is now only using Soma via impermissible hindsight reconstruction.

"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 50 USPQ2d 1614, 1617 (CAFC 1999). See also In re Kotzab, 55 USPQ2d 1313, 1316 (CAFC 2000). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." Dembiczak at 1617. "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." Dembiczak at 1617. "The patent examination process centers on prior art and the examination thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness . . . The factual inquiry must be thorough and searching. It must be based on

objective evidence of record.” In re Sang-Su Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Further, the Examiner appears to misunderstand the differences between the invention and Soma. The Examiner has simply extracted several conditions relevant to the invention from Soma and has combined them in order to reconstruct conditions that mimic the features of the present invention.

Thus, the Examiner has not considered if these conditions and materials extracted from the prior art are practical in terms of the battery chemistry. That is, the Examiner's reasoning does not take into account the difference between plasma spraying and sintering. The Examiner has not factually established how the reconstruction of the prior art can technically result in the present invention.

It is the Appellants' opinion that when extracting relevant conditions from the disclosure of Soma and simply combining them according to the Examiner's theory, the resulting compounds are not chemically consistent with respect to the chemical structures of the compounds that the inventive battery produces. Clearly, the Examiner has not established a *prima facie* case of obviousness.

That is, as the Examiner admits, Soma is only utilized for materials. Thus, the invention fails to be encompassed by the general and sometimes inconsistent conditions described in Soma. The Examiner therefore fails to appreciate that the invention satisfies all the following conditions:

- i) being consistent in terms of chemical structures,
- ii) being capable of retaining the stable conductivity required for an interconnector, even under an oxidation/reduction atmosphere at high temperature, and
- iii) being produced easily.

None of the above features could be predicted from Soma.

Also, at page 6, lines 15-17 of the Examiner's Answer, the Examiner states: "Regarding the declarations filed under 37 C.F.R. 1.132, these declarations are only believed to be relevant to the rejections over the Soma reference alone (now withdrawn) and not to the rejection over JP '913 in view of Soma."

However, Office personnel should consider all rebuttal arguments and evidence presented by applicants. See, e.g., In re Soni, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

Further, both the inability to establish *prima facie* obviousness and the unexpected results should establish patentability of the claimed invention. "The determination of obviousness, *vel non*, requires that all the evidence be considered together . . . if rebuttal evidence of adequate weight is produced, a holding of *prima facie* obviousness, being but a legal inference from previously uncontradicted evidence, is dissipated. The objective evidence of unobviousness is not evaluated for its 'separate knockdown ability' against the 'stonewall' of the *prima facie* case . . . but is considered together with all other evidence, in determining whether the invention is as a whole would have been

obvious to a person of ordinary skill in the field of the invention." (citations omitted). Applied Materials Inc. v. Advanced Semiconductor Materials, 98 F.3d 1563, 1569 40 USPQ2d 1481, 1485 (Fed. Cir. 1996).

As a result, the Examiner erred when refusing to give the Declarations patentable weight over JP '913 in view of Soma. The Examiner further errs in not taking into account the technical distinctions between plasma spraying and sintering.

Conclusion

Based on the above considerations, the Appellants accordingly continue to maintain that the Examiner's prior art rejection over JP '913 in view of Soma as set forth in the final Office Action remains improper, both in fact and in law. The Examiner further has not established a *prima facie* case of obviousness and fails to take into account Appellants' rebuttal evidence. The Examiner's new points of arguments have not changed this position. The Appellants therefore respectfully request the Board of Appeals reverse the Examiner's final rejections of the appealed claims and render a decision favorable to the Appellants.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

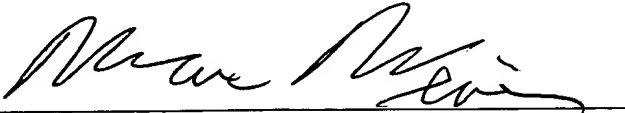
Reply Brief of Nov. 29, 2004

Appl. No.: 09/118,833

Response to Examiner's Answer of Sept. 29, 2004

Respectfully submitted,

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